

AMENDMENTS

In the claims:

Please amend the claims as follows:

E *Sub F2* (Twice Amended) A therapeutic combination as claimed in claim 1 wherein said bacterial filter is located [in] substantially within a wall of said canister.

REMARKS

Claims 2 through 8 stand rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which Applicant regards as the invention. In particular, the Office Action asserts: (1) that the recitation of claim 2, placing the filter inside the canister, is inconsistent with the recitation of claim 1, placing the filter between the canister and the pump; (2) that there is no antecedent basis for the recitation in claim 5 of "the interior," and (3) that claim 8, which recites a dressing, is inconsistent with claim 1, which does not recite a dressing. Notwithstanding the amendment to claim 2, made in order to expedite the present prosecution, Applicant respectfully traverses each said rejection.

As noted, Applicant has amended claim 2 in an effort to expedite the present prosecution. As amended, claim 2 recites the bacterial filter being "located substantially within a wall of said canister." This recitation is completely consistent with the recitation of claim 1 as location at the wall of the canister, much as shown in the Figures accompanying Applicant's application, may place the filter between the canister and pump. In light of this amendment, Applicant respectfully requests reconsideration of claim 2 and withdrawal of the rejection under 35 USC §112.

As to the rejection of claim 5, Applicant respectfully calls the Examiner's attention to the Office's own internal guidance as set forth in MPEP §2173.05(e), clearly explaining that "[i]nherent components of elements recited have antecedent basis in the recitation of the components themselves." See MPEP §2173.05(e) (giving example that "the limitation 'the outer surface of said sphere' would not

require an antecedent recitation that the sphere has an outer surface"). The pad's interior is inherent thereto; no further recitation is required. Withdrawal of the rejection is therefore respectfully requested.

Turning now to claim 8, Applicant must admit some uncertainty as to what in particular the Examiner has found objectionable.¹ Claim 1 recites a therapeutic combination comprising, *inter alia*, a pad and a canister. Claim 8 recites the therapeutic combination of claim 1 comprising, *inter alia*, the pad and canister and "*further comprising* an elastomeric film dressing." Claim 8 (emphasis added). Notwithstanding the fact that the dressing is clearly not a part of the combination *as recited* in claim 1, the dressing is clearly a part of the combination *as recited* in claim 8. That a further element may be recited in a dependent claim to narrow the recitation of its base claim is elementary. If all recitations of dependent claims were required to be made in their respective base claims all patents would have but one claim. The Examiner's assertions with respect to claims 1 and 8 are without basis in the law. If, however, confusion remains on this point Applicant respectfully requests a telephone interview at which time the Examiner is invited to cite authority for the rejection. In the meanwhile, Applicant respectfully requests withdrawal of the rejection without more.

Claims 1, 3 through 6 and 9 through 12 stand rejected under 35 USC §102(e) as being anticipated by U.S. patent No. 5,466,229 issued November 14, 1995 to Elson *et al.* ("Elson"). Under 35 USC §102, every limitation of a claim must identically appear in a single prior art reference, as arranged in the claim, for that reference to anticipate the claim. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). While Applicant does not now concede Elson to be prior art to the claimed invention, Applicant nonetheless traverses this rejection on the merits because, as will be conclusively shown, the identity element of anticipation is clearly not present.

In claim 1, Applicant recites, *inter alia*, "at least one bacterial filter interposed said canister and said pump." Claim 1 (emphasis added). While Elson may disclose several of the other recited elements in

¹ Applicant notes that claim 8 stands twice amended as of the Reply filed August 27, 1999 and incorporated by reference in the Continued Prosecution Application established September 15, 1999. The nature of the Examiner's remarks cause Applicant to question whether the claims were considered as amended on August 27, 1999 (September 15, 1999). If not, Applicant respectfully requests reconsideration of each claim then amended.

similar arrangement to the claimed apparatus, including a suction pump and a collection canister, Elson fails to disclose, either expressly or inherently, a bacterial filter interposed the pump and canister. In fact, to Applicant's best reading, the only mention in Elson of a filter is the filter 138 discussed briefly at Elson, col. 10, lines 33-39. In the brief discussion, Applicant finds no detail of the filter's construction, let alone such particular details as would be necessary to qualify the filter 138 as a "bacterial" filter. The positively recited limitation being clearly absent from the disclosure, Elson cannot anticipate claim 1. *See Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1572 (Fed. Cir. 1992) (noting that absence from reference of any claimed limitation negates anticipation); *see also bond*, 910 F.2d at 832 (noting every limitation must appear identically as arranged in claim in order for reference to anticipate). The rejection thus shown to be improper, Applicant respectfully requests its withdrawal and allowance of claim 1, as well as claims 3 through 6 and 9 through 12, which depend therefrom.

Claim 7 stands rejected under 35 USC §103(a) as being unpatentable over Elson in view of U.S. patent No. 5,437,651 issued August 1, 1995 to Todd *et al.* ("Todd"), which, like Elson, is in no manner admitted to be prior art to the invention of the present application. Although claim 7 depends from claims 1 and 2, the rejections of each being overcome by the arguments *supra*, Applicant nonetheless now points out that Elson is directed toward a urine collecting device. As has been painstakingly pointed out with respect to the previously cited international application of Kuntz², this subject matter is neither analogous nor pertinent to Applicant's invention as claimed. By this reference, those arguments previously made with respect to Kuntz are incorporated herein and repeated verbatim with respect to Elson, which Applicant now respectfully requests be eliminated as a reference under 35 USC §103.

² It is noted that the previously cited Kuntz reference appears to be related to the Elson reference not only in similarity of subject matter but also in common inventorship. Withdrawal of the Kuntz reference and mooting of Applicant's arguments in favor of the citation of a new reference of such similar character serves only to delay prosecution and severely frustrates Applicant's opportunity to condition the application for appeal. As a result, the Examiner is respectfully requested to finally conduct a complete search of the prior art upon which the best rejections, if any, should be issued in order that Applicant may fully develop an appropriate reply for the Examiner's consideration and appellate review as necessary.

Finally, claims 14 and 15 stand rejected under 35 USC §103(a) as being unpatentable over U.S. patent No. 4,460,361 issued July 17, 1984 to Nichols (“Nichols”) in view of U.S. patent No. 3,804,090 issued April 16, 1974 to Holbrook (“Holbrook”). Additionally, claim 15 stands further rejected under 35 USC §103(a) as being unpatentable over Nichols in view of Holbrook and U.S. patent No. 5,234,419 issued August 10, 1993 to Bryant *et al.* (“Bryant”). Applicant respectfully traverses each said rejection.

By this reference, the arguments of August 27, 1999 and earlier with respect to claims 14 and 15 are incorporated herein and repeated verbatim. Additionally, Applicant points out that it has in fact replied to the earlier rejections in full compliance with the Code of Federal Regulations. The Examiner has failed to carry his burden to establish a *prima facie* case of obviousness. In support of this position, Applicant has pointed out that the Examiner has failed to show any teaching or, for that matter suggestion, within the prior art itself for the positively recited structure of a deflector for diverting fluid towards the bottom of the container and away from the outlet incorporating the filter. To the contrary, the Office Action relies upon the Examiner’s location within the cited references of various components of the claimed invention as found in other arrangements and, notable, includes no explanation *other than the Examiner’s own conjecture* for why one of ordinary skill in the art would be motivated to rearrange those elements to arrive at Applicant’s invention. Further, even were such a suggestion present, the elements of the cited references would combine to form something other than the claimed invention as the Office Action clearly oversteps *Graham*, as well as all known tenets of claim construction, in arbitrarily and capriciously “[considering] the deflector to be the portion of [the inlet] that is protruding into the interior of the container.” The “deflector” is separately claimed by Applicant to deflect fluids away from the inlet. Such deflection stands apart from and in addition to any directional capability of the inlet itself. A *prima facie* case having not been established, Applicant is entitled to allowance of the claims without more. Withdrawal of the rejections is therefore respectfully requested.

In light of all the foregoing, Applicant respectfully requests reconsideration and allowance of the claims and passage to issue of this present application.

Respectfully submitted,

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